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JUN 13 1997 #24 T.P.

REPLY BRIEF FOR APPELLANT, JEAN-MARIE CLEMENT

U.S. PATENT & TRADEMARK OFFICE

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

97-1202
(Serial No. 08/054,951)

IN RE CLEMENT

APPEAL FROM A DECISION OF THE BOARD OF PATENT
APPEALS AND INTERFERENCES DATED JUNE 26, 1996

Date: June 13, 1997

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IN RE CLEMENT

Certificate of Interest

1. The full name of the party represented by me is Jean Marie Clément.
2. The name of the real party in interest represented by me is Jean Marie Clément.
3. There are no parent companies, subsidiaries or affiliates that have issued shares to public, of the party represented by me.

Christopher S. Schultz
Christopher S. Schultz

Date: February 5, 1997

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ARGUMENT

I. A Reissue Claim is Barred by the Recapture Rule Only When the Patentee Previously Admitted That the Reissue Claim Was Not Patentable

Under the proper interpretation of the recapture rule, regardless of the presence or absence of particular limitations in the reissue claims, the recapture rule does not apply "where the deliberate cancellation [or amendment] of claims does not amount to an admission that the reissue claims were not patentable at the time the original claims were cancelled [or amended]." Ball Corp. v. United States, 729 F.2d 1429, 1435, 221 USPQ 289, 294 (Fed. Cir. 1984); see also, Mentor Corp. v. Coloplast, Inc., 998 F.2d 992, 996, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993).

The Solicitor's response to this well-settled legal principle is a fundamental misconstruction of the recapture rule. The Solicitor's brief attempts to exhume an interpretation long ago interred by this Court and its predecessor, the Court of Customs and Patent Appeals (CCPA), see Ball Corp., 729 F.2d at 1435-36, 221 USPQ at 294; In re Richman, 409 F.2d 269, 274, 161 USPQ 359, 362-63 (CCPA 1969), arguing that the recapture rule operates in the same manner as prosecution history estoppel, prohibiting the broadening of limitations added during the prosecution of the original patent:

Thus, appellant attempts to eliminate numerous limitations from claim 1, including limitations with respect to: (i) temperatures, (ii) values of mechanical energy, and (iii) pH conditions. However, the recapture rule prohibits such conduct since during the original prosecution of the '179 patent, appellant argued that these same limitations, both alone and in combination, distinguished his invention from the prior art.

(Sol. Br. at 20-21.)¹ Furthermore,

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Sol. Br. refers to the Brief for the Commissioner of Patents and Trademarks.

[t]he recapture rule bars appellant from broadening these material limitations that were added during original prosecution to avoid prior art.

(Sol. Br. at 31.) The Solicitor improperly focuses on particular limitations added during prosecution of the '179 patent, and incorrectly requires that these exact limitations be contained in any reissue claims. This interpretation of the recapture rule has been expressly considered and repeatedly rejected by this Court and the Court of Customs and Patent Appeals.² See e.g., Ball Corp., 729 F.2d at 1434-36, 221 USPQ at 293-95.

Since the Solicitor has pointed to no instance where Clement ever implicitly or explicitly admitted that his reissue claims were not patentable, the recapture rule does not apply to Clement's reissue claims, and accordingly does not prevent Clement from asserting "error without deceptive intent" under the reissue statute. See 35 U.S.C. § 251.

A. In Applying the Recapture Rule, the Scope of the Reissue Claims Must Be Compared to the Scope of the Cancelled Claims

The analytical tool used to determine whether there was an admission that a reissue claim is not patentable is a comparison of the scope of the reissue claim to the scope of the claims cancelled or amended during the prosecution of the original patent. Ball Corp., 729 F.2d at 1436, 221 USPQ at 295. If the scope of the claims is substantially the same, or if the reissue claim is broader in all respects, the cancellation or amendment of the original patent claim was tantamount to an admission that the reissue claim was not patentable. Id. This admission cannot be regarded as error, and there is no basis for reissue. See In re Willingham, 282 F.2d 353, 357, 127 USPQ 211, 215-16 (CCPA 1960) ("The deliberate cancellation of a claim of an original application

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As discussed in §§ I.C and I.D, *infra*.

in order to secure a patent cannot ordinarily be said to be an 'error' and will in most cases prevent the applicant from obtaining the cancelled claim by reissue.") (emphasis added).

On the other hand, if the reissue claims are narrower in some significant respect than the cancelled or amended claims, there can be no inference of an admission of the unpatentability of the reissue claim, since the scope of the reissue claim was never admitted to be unpatentable. Under those circumstances, error can be asserted, and the recapture rule does not apply. See Ball Corp., 729 F.2d at 1436, 221 USPQ at 294-95; In re Wadlinger, 496 F.2d 1200, 1206, 181 USPQ 826, 832 (CCPA 1974).

B. Since Clement's Reissue Claims are Narrower in Several Significant Respects than Any Cancelled Claim, the Recapture Rule Does Not Apply

1. The Reissue Claims Must Only be Materially Narrower in One Significant Respect

As discussed in section I.A.3 of Clement's main brief, reissue claims that are narrower than claims cancelled or amended during prosecution of the original patent are not subject to the recapture rule. See Ball Corp., 729 F.2d at 1436, 221 USPQ at 295; In re Petrow, 402 F.2d 485, 488, 159 USPQ 449, 451 (CCPA 1968); Whittaker Corp. v. UNR Ind., Inc., 911 F.2d 709, 713, 15 USPQ2d 1742, 1745 (Fed. Cir. 1990). It is well settled that where the reissue claim is materially narrower with respect to a significant limitation or limitations, even if broader in other respects, the recapture rule does not apply, as the cancellation of the original claim cannot be construed as an admission that the reissue claim with the new, material limitation or limitations was not patentable. In re Richman, 409 F.2d at 276, 161 USPQ at 364 ("It is thus apparent that each of the appealed claims is more restrictive in at least one significant respect than the cancelled

claims and that appellant is not seeking, through the presentation of claims 23-28, to recapture the same subject matter that he sought in cancelled claims 1-15.").

A review of each of the opinions considering this issue confirms the foregoing view of the law, and demonstrates that Clement does not "mischaracterize[] the law regarding reissue to this Court," as alleged by the Solicitor, (Sol. Br. at 33). For example, in Ball Corp., the reissue claims were broader than the cancelled claims in one respect. The reissue claims dropped the limitation that the antenna was cylindrical. Ball Corp., 729 F.2d at 1438, 221 USPQ at 295. The reissue claims, however, were narrower in other material respects. Id. at 1437, 221 USPQ at 295. Even though the cancelled claims were broader in one respect, the Court stated that this fact did not bar reissue since "the reissue claims are not substantially identical in scope to the cancelled claims," and are "sufficiently narrower than the cancelled claims to avoid the effect of the recapture rule." Id. at 1438, 221 USPQ at 296.

In In re Willingham, 282 F.2d 353, 127 USPQ 211 (CCPA 1960) the patentee was pursuing a reissue claim that was narrower in some respects but broader in other respects than original claim 12 which was cancelled during prosecution. The court stated:

Reissue claims 3 and 6 are narrower than claim 12 with respect to the eccentric opening but are broader than this claim in the limitations relating to the flutes. Thus, the issue before us is not the issue presented in many reissue cases in which an applicant cancels a claim to secure the issuance of the patent and then seeks to recapture it by a claim of the same scope in a reissue application.

Id. at 356, 127 USPQ at 215 (emphasis added). The fact that the reissue claims were materially narrower in one respect precluded the application of the recapture doctrine:

The appealed claims differ materially from cancelled claim 12 and there is nothing of record on which to base a holding that the cancellation of

claim 12 was in any sense an admission that the reissue claims on appeal were not in fact patentable to appellant at the time claim 12 was deleted.

Id. at 357, 127 USPQ at 215-16.

Patecell v. United States, 12 USPQ2d 1440 (Cl. Ct. 1989), cited in the Board opinion, (A11), cogently discusses the situation where a reissue claim is broader in some respects, and narrower in other respects, than the cancelled claims:

[W]hen the reissue claim is narrower than the cancelled claim in a material respect, a similar conclusion as to the patentee's intent and hence, as to the absence of 'error' cannot be made based exclusively on a comparison of the reissue claim with the cancelled claim. . . . Therefore, one cannot presume merely from the act of cancelling a claim that a patent applicant made a deliberate judgment that a second claim that is narrower in a certain respect than the cancelled claim also would be unpatentable.

That conclusion should not change when the second claim, while narrower in at least one respect, is also broader in some other respect. The applicant may have agreed with the patent examiner that the original claim was unpatentable but may not have considered, when cancelling the claim, that the claim could have been rendered patentable by the addition of a particular limitation. Hence, a deliberate decision to cancel a particular claim because it is unpatentable would not necessarily constitute a deliberate judgment that a claim that is broader in some ways and narrower in others also would be unpatentable.

Id. at 1447 (emphasis added).

2. Clement's Claims are Materially Narrower in Several Significant Respects than Any Cancelled Claim

Even if the addition of limitations during prosecution of the '179 patent was an admission that the pending claim prior to amendment or cancellation was not patentable over the prior art, this fact does not bar reissue claims 49-52 under the recapture rule.

Reissue claim 49, while broader in some respects, is materially narrower in several other significant respects than the narrowest cancelled or amended claim in the

'179 prosecution history.³ Application claim 42, as amended on June 29, 1987, was the narrowest claim that eventually was later amended, (A378-80; Cl. Br. at 10-11), and therefore is the narrowest claim that arguably was admitted to be unpatentable. After the June 29 amendment, claim 42 was later finally amended and allowed in its amended form. (A427-29.) A comparison of reissue claim 49, to application claim 42, (Cl. Br. at 10-11), after the June 29 amendment and prior to the last amendment before allowance, shows beyond dispute that claim 49 is materially narrower in several significant respects. Reissue claim 49 includes the following limitations which are not found in this claim 42:

- (1) [prior to the ink softening and detaching steps] releasing and removing substantially all the non-ink contaminants,
- (2) including the stickies,
- (3) to provide a brightness of at least 59 ISO in the final pulp.

(A428.) All three of these limitations were explicitly mentioned by the Examiner in the Statement of Reasons for Allowance:

- (1) Burns clearly cleans non ink contaminants from his stock after the dispersal unit and flotation as well as before the dispersal unit whereas applicant cleans only before the disperser, which is claimed in step (b) via cleaning substantially all the non-ink contaminants
- (2) Burns does

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If Clement's reissue claims are not an attempt to recapture the "narrowest" of the cancelled or amended claims, it is axiomatic that recapture also does not apply to broader cancelled or amended claims. Clement focused on claim 1 prior to the July 9, 1985 amendment in its brief, because that is the claim the Board asserted Clement was trying to recapture. (Cl. Br. at 23-29). Contrary to the assertion of the Solicitor, Clement never suggested that only one piece to the prosecution history is relevant in determining whether the recapture rule applies.

not recognize the removal of stickies prior to the dispersal unit as now claimed with room temperature pulping and cleaning and (3) Burns does not recognize the achievement of the specific brightness now claimed..

(A428-29.)

In contrast, the claim 42 limitations which are not found in reissue claim 49 and whose absence renders claim 49 broader were hardly material to patentability, as they did not render claim 42 patentable and were found by the Examiner to be conventional in the prior art. (A269, A412-13.) Since claim 42 did not contain three claim 49 limitations material to patentability, and since the claim 42 limitations omitted from claim 49 were not material, any admission that claim 42 prior to the final amendment was not patentable does not and cannot amount to an admission that reissue claim 49 is not patentable. Moreover, since the Examiner determined that reissue claim 49 is patentable over the prior art, a finding not contested by the Solicitor, reissue claim 49 must be of a materially different scope than claim 42.

C. The Solicitor Improperly Focused on the Broadening of Particular Limitations in the Reissue Application

The Solicitor's "estoppel" review of recapture in the present case is virtually identical to the position proffered by the Government in Ball Corp. and expressly rejected by this Court. This Court in Ball Corp. 729 F.2d at 1434-36, 221 USPQ at 294, addressed a conflict in the case law in the application of the recapture rule. One line of cases from the CCPA focused its recapture analysis on whether the deliberate cancellation or amendment of claims amounted to an admission that the reissue claims were not patentable:

In *In re Petrow*, the CCPA went so far as to state that error is sufficient where the deliberate cancellation of claims does not amount to an admission that the reissue claims were not patentable at the time the

original claims were cancelled. . . . Thus, the CCPA has construed the term error under section 251 broadly.

Id. at 1435, 221 USPQ at 294.

A second line of non - CCPA opinions, like the Solicitor's position in the present case, focused on limitations added to secure a patent and the necessity for the reissue claims to contain these same limitations. Id.:

The Ninth Circuit employed a more rigid standard in *Riley v. Broadway-Hale Stores, Inc.* stating: "when the chief element added by reissue has been abandoned while seeking the original patent, the reissue is void."

Riley v. Broadway-Hale Stores, Inc., 217 F.2d 530, 103 USPQ 414 (9th Cir. 1954), is indistinguishable from the position advanced by the Solicitor in the present case. In Riley the invention was to foam rubber shoulder pads which included recesses called "voids." 217 F.2d at 531, 103 USPQ at 415. During the prosecution of the original patent,

[t]he original application included claims for shoulder pads without voids. All of the original claims were rejected by the Patent Office. The claims to pads without voids were abandoned, but those for shoulder pads with voids were prosecuted. Eventually appellant accepted a patent limited to shoulder pads with voids, and thereupon obtained the reissue primarily for the purpose of covering the very element deliberately abandoned. . . . In our opinion, when the chief element added by reissue has been abandoned while seeking the original patent, the reissue is void.

Id. at 532, 103 USPQ at 415.

After considering both positions, this Court adopted the view that unless the cancellation or amendment of a claim is tantamount to an admission that the reissue claims were not patentable, the recapture rule does not apply. Concomitantly, this Court rejected the Solicitor's view herein that the patentee is per se estopped from broadening

or deleting limitations added to avoid prior art during the prosecution of the application resulting in the patent:

The trial judge sought to determine whether Ball had made a deliberate judgment that claims of substantially the same scope as the new reissue claims would have been unpatentable. The Government, arguing from *Riley*, submits that the trial judge's approach loses sight of the feature given up by a patentee in order to secure the original patent. We decline to adopt the rigid standard applied in *Riley*, in favor of the more liberal approach taken by the CCPA.

729 F.2d at 1435-36, 221 USPQ at 294 (emphasis added). Indeed, prosecution history estoppel and reissue recapture are two different and distinct doctrines. Focusing on specific claim limitations is required for a prosecution history estoppel analysis, Werner-Jenkinson v. Hilton Davis, 117 S. Ct. 1040, 1054 (1997), but prohibited in recapture analysis, Ball Corp., 729 F.2d at 1436, 221 USPQ at 295.

D. The Solicitor's View of the Recapture Rule If Adopted, Would Require This Court to Overrule Ball Corp., In re Richman, and In re Wesseler

If the Solicitor's interpretation of the recapture rule were applied to the facts of Ball Corp., In re Richman, 409 F.2d 269, 161 USPQ 359 (CCPA 1969), and In re Wesseler, 367 F.2d 838, 151 USPQ 339 (CCPA 1966), a different result likely would have been reached in each case. Such an interpretation would, therefore, require this Court to overrule the holdings in those opinions.

In Ball Corp., the invention was drawn to an antenna including inner and outer cylindrical concentric conductive elements which are connected to a source by *one or more* coaxial transmission feedlines. During prosecution, however, the patentee deliberately limited his claims to require *a plurality* of feedlines to be connected to the outer conductor. Ball Corp., 729 F.2d at 1432, 221 USPQ 291-92. This limitation

overcame prior art over which the claims were rejected that disclosed *a single* feedline.

Id.

During the reissue proceedings, the patentee attempted to broaden his claims to cover *single* feedline antennae by deleting the *plurality* of feedlines limitation, the very limitation added to the claims to overcome the prior art and obtain a patent. Id. at 1433, 221 USPQ at 292 ("Ball identified as error the undue limitation of the claims of the original patent to a plurality of feedlines."). In comparing the scope of the reissue claim with the scope of the claim cancelled during prosecution, this Court held that the patentee in Ball Corp. could remove the *plurality of feedlines* limitation that was deliberately added to overcome *single feedline* prior art to attain allowance of the claims. Id. at 1437, 221 USPQ at 295-96. The determinative factor was that the "reissue claims, in contrast, include limitations not present in the cancelled claims," and thus were narrower than the cancelled claims in other respects. Id. at 1438, 221 USPQ at 295.

Applying the Solicitor's logic advanced in the instant case to Ball Corp., the plurality of feedlines limitation should have been contained in any reissue claims, as it was added to the claims to overcome the prior art. Thus, should this Court adopt the Solicitor's interpretation of the recapture rule, it would have to overrule the holding in Ball Corp. because the Solicitor asserts "[t]he recapture rule bars appellant from broadening these material limitations that were added during original prosecution to avoid prior art."⁴ (Sol. Br. at 31.)

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Under the Solicitor's reasoning, the situation in Ball Corp. was a more egregious recapture situation than the present case, since the limitation broadened in Ball Corp. recaptured the very change that caused the original claims to be allowed. In contrast in

In re Richman, also was an example of a patentee pursuing reissue claims that did not include limitations added during prosecution of the original patent to distinguish over the prior art. The Solicitor in Richman also advanced exactly the same flawed recapture argument presented by the Solicitor in this case:

The solicitor says the question raised by this rejection may be stated as follows:

May Appellant, having deliberately included a certain limitation in each of his patent claims and successfully urged the patentability thereof over prior art applied against replaced original claims 1-15 on the basis of a maximum-zero control signal relationship broadly represented by the limitation, now omit that limitation in reissue claims 23-28.

409 F.2d at 274, 161 USPQ at 362. The CCPA disagreed with this phrasing of the recapture rule:

We do not consider this to be an accurate statement. The rejection which the board affirmed is grounded on the proposition that the appealed claims are directed to the same subject matter as cancelled claims 1-15 and that appellant is estopped to "recapture" that subject matter by reissue. The question raised is whether the appealed claims are of the same scope as the cancelled claims, not whether they lack some specific recitation absent from the cancelled claims but included in the patent claims.

Id. (emphasis added).

The CCPA then found that the deliberate addition of limitations to avoid the prior art can be error without deceptive intent correctable by reissue, as long as the reissue claim does not recapture the same or broader scope as a deliberately cancelled or amended claim:

the present case, the limitations argued by the Solicitor to be necessary were not the basis for allowance of the claims. (Cl. Br. at 7-11.)

We therefore find neither decision to be authority for the proposition that a limitation added to a claim in obtaining its allowance cannot be broadened, under present statutory law, by reissue if the limitation turns out to be more restrictive than the prior art required. Certainly one might err without deceptive intention in adding a particular limitation where a less specific limitation regarding the same feature, or an added limitation relative to another element, would have been sufficient to render the claims patentable over the prior art.

Id. at 274-75, 161 USPQ at 363 (emphasis added).

Like Ball Corp., if adopted, the Solicitor's interpretation of the recapture rule would require this Court to overrule the holding of In re Richman.

The Solicitor's argument herein was also explicitly raised and rejected in In re Wessler:

The first line of reasoning employed by the board is that the inclusion of the specific limitation [to avoid prior art] in the patent claims prohibits appellant from obtaining any reissue claim omitting that limitation.

367 F.2d at 847, 151 USPQ at 346. Consistent with Ball Corp. and In re Richman, the CCPA held in In re Wessler, that the deliberate addition of limitations to the original patent claims could be error, as long as the reissue claim is not broadened to be of the same scope as a cancelled claim, or to encroach on the prior art:

Shepard may be support for the rule that one who deliberately adds a limitation to avoid the prior art cannot omit that limitation in reissue claims so as to encroach upon the prior art, but that is not the situation here as the board's opinions clearly point out.

367 F.2d at 849, 151 USPQ at 348 (emphasis added). Accordingly, the CCPA held that there was no reason that the patentee could not assert error in that situation.

E. The Solicitor's Reliance on the District Court Opinion in Kamyr v. Clement is Completely Misplaced

In support of its flawed "estoppel" analysis, the Solicitor attempts to rely on the opinion in Kamyr v. Clement, 952 F. Supp. 12 (D. D.C. 1997), in which the district court

granted summary judgment of non-infringement with respect to claim 1 of the '179 patent.⁵ Summary judgment was based in part upon the finding that Clement was precluded by the doctrine of prosecution history estoppel from asserting that Kamyr's process infringed claim 1 under the doctrine of equivalents. The single limitation which formed the basis for the district court's opinion was the step of removing "substantially all the non-ink contaminants including the stickies" recited in claim 1 which the District Court found not to exist either literally or equivalently in Kamyr's process. Id. at 17. This very limitation is still present in reissue claim 49 and has not been deleted or broadened. How this finding supports the Solicitor's position that Clement cannot broaden other limitations through reissue is unknown.

Indeed, the district court found no prosecution history estoppel with respect to a limitation that the Solicitor contends Clement cannot broaden through reissue, the "room temperature" limitation:

Kamyr fares no better with its estoppel argument addressed to Clement's claim that the temperature of Kamyr's initial step is equivalent to that of the '179 patent process. The prosecution history establishes that the Examiner required Clement to use terms more specific than 'low temperature,' but it does not reflect a requirement by the Examiner or an intent by Clement to specify any particular temperature in order to overcome prior art.

Id. at 17 (emphasis added).

The Solicitor's sweeping statement that "just as the court in Kamyr found that Mr. Clement was estopped from broadening his claims, the Board properly rejected appellant's reissue application based on the recapture rule," (Sol. Br. at 26), is a gross distortion of the true holding in the Kamyr case and a misrepresentation of the law. As

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This opinion is the subject of Appeal No. 97-1262 which is pending before this Court.

argued above, prosecution history estoppel is not the test for recapture and such a test has been repeatedly rejected by this Court and the CCPA. Moreover, even if prosecution history estoppel is the proper test, the Kamyr court's finding that Clement is not estopped from asserting a somewhat broader range of equivalents with respect to the room temperature limitation would mean that recapture should not bar any broadening of this limitation in a reissue claim.

F. This Court's Opinion in Mentor Corp. Does Not Support the Solicitor's
Attempted Application of Estoppel to the Recapture Rule

The Solicitor in its brief completely ignores the foregoing overwhelming authority and latches onto a single quote taken out of context from Mentor Corp. v. Coloplast, Inc., 998 F.2d 992, 27 USPQ2d 1521 (Fed. Cir. 1993), to support its application of file wrapper estoppel to the recapture doctrine: "the reissue claims are broader than the original patent claims in a manner directly pertinent to the subject matter surrendered during prosecution." (Sol. Br. at 17, 20, 34.) This quote forms virtually the only basis for the Solicitor's position that Clement is estopped from broadening limitations added during prosecution under the recapture rule. What was "surrendered" during prosecution in Mentor Corp., however, was the particular claim scope of the cancelled claims, not the absolute right to broaden particular claim limitations.

Moreover, the facts and holding in Mentor Corp., are readily distinguishable from the present case. In Mentor Corp., the patentee broadened a limitation added during prosecution so that the reissue claims were of substantially the same scope as claims cancelled during prosecution. Although the patentee argued that the reissue claims were materially narrower in some respects, this Court found that "the added

limitations do not narrow the claims in any material respect compared with their broadening," 998 F.2d at 996, 27 USPQ2d at 1525, and applied the recapture rule.

Mentor Corp. nowhere states that a limitation added during prosecution may not be broadened, regardless of whether the reissue claim is materially narrower in some other respect than the cancelled claim. Indeed, the Court in Mentor Corp. indicated that if the reissue claims were "materially narrower," as in the instant case, the result would have been different. Id. at 996-97, 27 USPQ 2d at 1525. The holding in Mentor Corp. is therefore fully consistent with Clement's position herein and with the holding in Ball Corp.

G. Even if the Solicitor's Estoppel Version of Recapture Applies, The Prosecution History Does Not Estop Clement From Broadening These Limitations

The Solicitor's claim that estoppel bars the reissue claims under the recapture doctrine because of arguments Clement made during prosecution is equally unavailing. (Sol. Br. at 18-23.) The Solicitor claims that Clement should be limited to the specific temperature, mechanical energy, and pH values of claim 1 because of arguments in the prosecution history.⁶ The quoted portions of the record on page 22 of the Solicitor's brief were intended to support the argument that the "essential aspect of the Applicant's invention [is], namely the combination of high temperature mechanical energy and high

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The statement by the Solicitor that the reissue claims are not limited to "any" values of temperature, mechanical energy and pH is untrue. Each of these limitations is qualified by a limitation, e.g., "temperature below the melting point of the non-ink contaminants, . . . specific mechanical energy sufficient to form a pumpable slurry and to release substantially all of the non-ink contaminants including the stickies," etc. (A25.)

consistency." (Sol. Br. at 22.) None of the arguments referred to by the Solicitor, however, distinguishes Appellants' invention based on the specific temperature, mechanical energy, and pH levels deleted from reissue claim 49. Rather, Clement's identified patentability arguments were more broadly stated and are still applicable to reissue claim 49.

Additionally, the room temperature limitation, and the specific mechanical energy limitation were added to avoid an indefiniteness rejection, not to overcome prior art. (A254-55.) The Examiner objected to terms such as "high" and "low" as being "too relative" [to be] capable of any fixed meaning." Id. This also explains the addition of the specific pH level to make definite the term "strong." (A345-46.) The high temperature limitation was present in the claims as filed. (A230.)

II. Clement is Fully Entitled to Present the Law Regarding the Recapture Rule

Even though Clement's claims were rejected under the recapture rule, the Solicitor contends that Clement is prohibited from arguing that the recapture rule does not apply,⁷ claiming that the precise arguments presented by Clement on appeal were not before the Board. The Solicitor then attempts to justify this rather dubious effort to exclude Clement's proper legal analysis by a complete mischaracterization of Clement's arguments on appeal: "(i) the recapture rule only requires that one compare the reissue claims with the original application claims prior to ever being amended due to a prior art rejection, . . . [and] (ii) the recapture rule does not apply so long as the reissue claims are

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Compare the Solicitor's efforts on one hand to exclude Clement's legal discussion with the Solicitor's own improper introduction in its brief of entirely new evidence outside of the record. (See section III.B.2, *infra*.)

narrower than his original application claims in at least one significant respect." (Sol. Br. at 26.)

As to the Solicitor's first argument, as is evident from section I.B.2 of Clement's initial brief, and section I.B.2, herein, Clement's position that the recapture rule does not apply in this case is based on a comparison of the scope of his reissue claims with the narrowest claim that was later amended in the prosecution history, not the original application claims.

As to the Solicitor's second argument, as is readily apparent from an inspection of this brief and Clement's initial brief, Clement's position is that the recapture rule does not apply if the reissue claims are materially narrower in at least one significant respect⁸ than each of the claims that were cancelled (or amended) during the original prosecution, and not just the original application claims.

Not surprisingly, since this issue was the focus of the entire examination process and of the appeal to the Board, the application of the recapture rule was argued many times in the prosecution history, and before the Board. For example, during the prosecution of the reissue application,⁹ in response to the recapture rejection, Clement specifically argued to the Examiner:

What the Examiner apparently fails to acknowledge is the Court's statement in this case that: "The recapture rule does not apply where there is no evidence that amendment of the originally filed claims was in any sense an admission that the scope of the claims was not in fact patentable." Mentor Corp., 27 USPQ2d at 1524.

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Here, the reissue claims are materially narrower in several significant respects than the narrowest application claims prior to cancellation or amendment.

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Application Serial No. 08/054,951.

... Thus, in view of the prosecution history of the '179 patent, it cannot be maintained that applicant admitted that claims which do not have limitations directed to the temperature, mechanical energy and pH were not patentable. Accordingly, the recapture rule as interpreted by the Examiner does not apply in this case.

(A52-53; A71-72) (emphasis added). Furthermore, in the parent application Serial No. 07/600,012, Clement stated that:

[i]t is entirely permissible for the patentee to acquire through reissue claims that are narrower in scope than the cancelled claims even if the reissue claims are broader than the original patent claims. This is specifically sanctioned in MPEP § 1412.02 wherein it is stated:

"The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were cancelled from the original application. On the other hand, the patentee is free to acquire, through reissue, claims that are narrower in scope than the cancelled claims." . . . Citing, Ball Corp. v. United States, 221 USPQ 289, 295 (Fed. Cir. 1984).

(A144-45.) It is apparent from the foregoing quotes that the law of Ball Corp. and the law of recapture was squarely presented to the Examiner and the Board.

The cases cited by the Solicitor do not support its flawed efforts. In Sewall v. Walters, 21 F.3d 411, 417-18, 30 USPQ2d 1356, 1360 (Fed. Cir. 1994), Sewall was not permitted to raise the issue of the on-sale bar, "[b]ecause this issue was not raised below." In the present instance, of course, recapture is one of two issues on appeal, and was squarely raised below.

In Chester v. Miller, 906 F.2d 1574, 1578 n.6, 15 USPQ2d 1333, 1337 n.6 (Fed. Cir. 1990), Chester was precluded from presenting new arguments on appeal that a prior art reference failed to enable the claimed subject matter, an entirely new legal theory. Again, here, Clement is not presenting new legal theories.

Lastly, in Wallace v. Department of the Air Force, 879 F.2d 829, 832 (Fed. Cir. 1989), Wallace on appeal, for the first time, challenged the validity of the performance standards upon which she was evaluated and removed. The issue of the validity of the standards was not before the Board and could not be addressed by this Court:

[T]he issue must be raised with sufficient specificity and clarity that the tribunal is aware that it must decide the issue, and in sufficient time that the agency can do so.

Id. at 832. Here, since the claims were rejected over the recapture rule, there is no doubt that the issue of recapture was properly and squarely before the Board and can now be argued by Clement.

III. Clement's Reissue Declaration Complies with the Rules

Clement has fully complied with 37 C.F.R. § 1.175 by specifying the errors in the patent and his conduct, how and when each error arose, and how and when each error was discovered. See Hewlett-Packard Co. v. Bausch and Lomb, Inc., 882 F.2d 1556, 1565, 11 USPQ2d 1750, 1758 (Fed. Cir. 1989). The Solicitor, however, contends that Clement's reissue declaration is defective because it does not refer to the "room temperature" limitation of step (b) of claim 1 of the '179 patent as being error and therefore does not comply with 37 C.F.R. § 1.175. Aside from this technical defect, the Solicitor's only remaining argument is, essentially, an assault on Clement's veracity.

A. The Room Temperature Limitation of Step (b) is Particularly Specified in Clement's Declaration

Exalting form over substance, the Solicitor argues that Clement's declaration is deficient since the declaration only refers to the step of forming the first fibrous suspension in step (a) "at room temperature" as being an error, and not also to the

recitation of removing by screening and cleaning non-ink contaminants "at room temperature" in step (b) of claim 1 as being an error. (Sol. Br. at 37.)

However, contrary to the Solicitor's contention that these two "room temperature" limitations "deal with entirely different parts of the process," (Sol. Br. at 40), both limitations specifically refer to sequential treatment of the same "first fibrous suspension," without the subtraction or addition of any heat. Moreover, it is apparent from the declaration that the error involved the "room temperature" limitation of the first fibrous suspension as set forth in both steps (a) and (b). For example, the declaration recites:

These limitations are, however, inconsistent with the invention in its broadest terms. As set forth in the specification at col. 6, lines 15-19, the important feature of the invention here is to keep the temperature of the stock as low as possible so that the low melting point contaminants will remain rigid and will not extrude through the slotted screens. Those skilled in the art will recognize that the first fibrous suspension can b[e] formed under any combination of heat and mechanical energy as long as the temperature of the stock is kept below the melting point of the non-ink contaminants and the non-ink contaminants are released from the surface of the paper.

(A39) (emphasis added). Further, col. 6, lines 15-19 of the '179 patent, referred to in the declaration above, states:

It is anyhow of paramount importance that the temperature of the stock be kept as low as possible so that the low melting point contaminants will remain rigid and will not extrude through the slotted screens and thus be eliminated by the screens.

(A20) (emphasis added).

The declaration explicitly refers to the temperature limitations of step (b) of claim 1, i.e., screening and cleaning the first fibrous suspension "at room temperature," as being "inconsistent" with the broad concept of screening and cleaning at a temperature below the melting point of the contaminants, as claimed in reissue claim 49.

Accordingly, it is apparent from the declaration that the error was the inclusion of the "room temperature" limitation in both steps (a) and (b).¹⁰

B. Clement Has Specifically Pointed Out How the Errors Arose and There is No Basis for Not Believing Him

The Solicitor can point to no other alleged technical deficiency in the declaration. The remainder of the Solicitor's attack on Clement's declaration amounts to an attack on his veracity. There is absolutely no reason to believe, however, that Clement was not truthful. See Manual of Patent Examining Procedure, § 1448 ("Applicant's statement of lack of deceptive intent normally will be accepted as dispositive except in special circumstances such as an admission or judicial determination of fraud or inequitable conduct."); Addendum at D1-2.

1. There Is No Inconsistency in Clement's Declarations

The Solicitor points to Clement's reissue declaration in the '951 application, (A36-43), and the reissue declaration filed in the parent application (the '012 application) (A130-35), and contends that they are inconsistent. (Sol. Br. at 39.) The '012 application declaration states, inter alia, that "[t]he above errors were discovered only

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Even if the Court finds the declaration to be deficient, this technicality is correctable, and, a remand permitting Clement to supplement the declaration to add the words "step b" would be appropriate. See Nupla Corp. v. IXL Mfg. Co. Inc., No. 96-1388 at 9 (Fed. Cir. May 12, 1997). Nupla held reissue claims invalid for failing to specify errors. Id. at 10. Note, unlike the present case, Nupla involved a district court's review of an issued patent. Thus, the deficiencies there were fatal to the reissue patent. Here, the application is still pending and technical errors in the Declaration could be addressed by a supplemental declaration on remand, or in a continuation application.

after I had an opportunity to completely analyze the text of the patent which issued in the United States." (A133.) The '951 application declaration states that "[t]he above errors were confirmed only after I had an opportunity to thoroughly discuss the invention face to face with my U.S. attorneys on April 22, 1993." (A41) (emphasis added). These statements are not inconsistent on their face, since earlier discovered errors could have been confirmed on April 22, 1993.¹¹

Furthermore, the two declarations were submitted for different errors in different claims. A comparison of the '012 application claim 19, (A121-23), and '951 application claim 42, (A28-29), reveals two substantially different claims. Thus, the associated differences between these claims and the original patent claims are different, and the "errors" respectively associated therewith are different, resulting in two declarations that should be different. Nupla Corp. v. IXL Mfg Co. Inc., No. 96-1388 at 9 (Fed. Cir. May 12, 1997) (amendments to claims during reissue requires submission of a new or supplemental declaration).

2. The Solicitor's Submission of a Translation of Clement's European Patent Application, While Improper, Fails to Support the Solicitor's Position

Apparently doubting the strength of its case on the record below, the Solicitor elected to go outside the record, in an entirely improper exercise of post-appeal evidence gathering. The Solicitor attached a European patent application, and a translation of claim 1 of that application not before the Examiner or Board below, and generated only during the extension of time agreed to by Clement and granted by the Court. These

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Note, the Solicitor carefully left out the word "confirmed" in its paraphrasing of the '951 declaration.

documents were attached as a "Supplemental Appendix" to its brief.¹² The Solicitor apparently believed that these documents contradicted Clement's '951 declaration. (Sol. Br. at 38 fn. 12; SA9-52.)

While these new documents should not be considered by the Court, Oshiver v. Office of Personnel Management, 896 F.2d 540, 542 (Fed. Cir. 1990) ("We will not consider the new evidence contained in the supplemental papers because that evidence was not presented to the Board."); In re Bed & Breakfast Registry, 791 F.2d 157, 160-61, 229 USPQ 818, 820 (Fed. Cir. 1986) ("We do not, of course, consider new evidence that was not before the examiner or the Board."), they provide no support for the Solicitor's contention.

The Solicitor stated that because Clement's European patent application contains the "high temperature -- between 85-130°C" limitation, the inclusion of that limitation in the U.S. application cannot be "error."¹³ This argument ignores the portions of Clement's reissue declaration that stated that the error resulted from a misunderstanding of U.S. patent law that occurred because communication difficulties with his U.S. attorneys:

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The Solicitor ignores Federal Circuit Rule 30(f) which only authorizes the creation of a supplemental appendix when the "appellant has failed to participate in determining the contents of the appendix," and then, only with "material permitted by (a)(2) of this Federal Circuit Rule 30."

¹³

The Solicitor failed to note that the European application also did not contain all the remaining missing limitations, i.e., the "room temperature," specific mechanical energy, and specific pH limitations.

I did not then appreciate, and my U.S. attorneys did not explain to me, that the process conditions under which the first fibrous suspension is formed and the softening, detaching and dispersing steps are carried out could be made more definite without reciting the specific parameters contained in original claim 1. The lack of appreciation on my part was due to my limited understanding of U.S. patent law

(A41.)

The nearly simultaneous inclusion of the specific temperature limitation in the European application is consistent with such an error. Clement thought the limitations would be interpreted the same in the U.S. as in Europe. However, interpretation of a specific claim limitation under European patent law is very different from the interpretation of that same limitation under U.S. law. European interpretation is much more liberal:

The extent of the protection conferred by a European patent or patent application will be determined by the terms of the claims. The description and drawings will be used to interpret the claims. The Protocol on the interpretation of the relevant Article (69) of the Convention provides, however, that the Article is not to be interpreted in the sense that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims.

World Patent Law & Practice, § 10.21[6] (1996) (emphasis added); Addendum at D3-5.¹⁴

What the Solicitor failed to appreciate was that the communication difficulties referenced by Clement in his declaration were not misunderstandings as to what limitations he directed his attorneys to add to the claims. Rather, the communication difficulties were the inability or failure of the U.S. attorneys to explain to Clement the legal significance of adding limitations to the claims. While a limitation present in a

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This European law was the standard with which Clement, a French citizen living in Italy, was familiar.

CERTIFICATE OF SERVICE

I, Christopher S. Schultz, attorney for Jean-Marie Clement, certify that on June 13, 1997, I served two copies of the affixed Reply Brief by overnight mail to the Office of the Solicitor, Crystal Park, Bldg. No 2, 2121 Crystal Drive, 9th Floor, Rm 918, Arlington, Virginia 22215.

Date: June 13, 1997

Christopher S. Schultz

European application may have been routinely added to the U.S. application to which it corresponded, Clement's communication difficulties with his U.S. attorneys did not allow him to appreciate the differences in practice and therefore the consequences of the added limitation in the U.S., as well as the fact that this limitation was not necessary to gain allowance of the claims. Moreover, because of these communication difficulties, Clement was unaware that unnecessary limitations appearing in the U.S. claims when filed could have been deleted during prosecution.

For the foregoing reasons, the Solicitor's attack on Clement's credibility is unavailing and the declarations should be found to satisfy 37 C.F.R. § 1.175.¹⁵

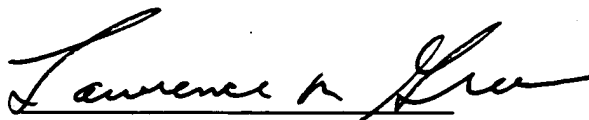
CONCLUSION

For the foregoing reasons, the decision of the Board should be reversed and claims 1-18 and 49-52 should be allowed.

Respectfully submitted,

JEAN MARIE CLEMENT

June 13, 1997



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The Solicitor apparently does not contend that the declarations do not comply with the reissue statute.